

## **REMARKS**

The Office Action Summary indicates that claims 1-74 are pending in the present application and that claims 1-63 and 71-74 have been withdrawn from consideration. Applicants respectfully note that claims 1-16 and 71-74 were canceled in the Response to Restriction Requirement Under 37 C.F.R. § 1.142 and Election of Species Under 37 C.F.R. § 1.146 filed on May 25, 2005. Accordingly, Applicants believe that claims 64-70 are pending.

Applicants have amended claim 1 to clarify that which Applicants regard as the invention. Specifically, claim 1 has been amended to recite, *inter alia*, that at least one of R<sup>30</sup>, R<sup>31</sup> or R<sup>32</sup> is present and is a therapeutic agent. This amendment merely clarifies the language of the claim. Applicant believe that no new matter is added by this amendment. Also, in claim 1, the letter "l" has been re-drawn to make it clearer.

After entry of this amendment, claims 64-70 will remain pending.

Entry of the foregoing amendments and consideration of these remarks is respectfully requested.

### ***Double Patenting***

The Examiner has provisionally rejected claims 64-70 under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-59 of co-pending Application No. 10/723,144 (the "144 application"). Specifically, the Examiner contends that the conflicting claims are not patentably distinct from each other because the presently claimed invention and the invention claimed in the '144 application are both drawn to peptide compounds of Formula (V) and Formula (I), respectively, which claim at least one overlapping species. The Examiner further contends that the instantly claimed product encompasses and/or is encompassed by the claimed product of the '144 application. Applicants respectfully disagree.

The legal standard for an obviousness-type double patenting rejection requires a comparison of what is *claimed* in the earlier patent, not what was disclosed in the specification of the earlier patent. See *e.g.*, *General Foods, Inc. v. Studiengesellschaft Köhle mbH*, 972 F.2d 1272, 1280-81 (Fed. Cir. 1992). Although the specification may be used to determine the meaning of terms used in the claims, the specification may not be used as prior art. See *e.g.*, *In re Vogel*, 422 F.2d 438 (C.C.P.A. 1970).

Applicants respectfully submit that claims 1-59 of the '144 application, which are directed to compounds of formula (I), do not render obvious the claimed compounds of formula (V). In particular, Applicants submit that the compounds of formula (V), in which at least one of R<sup>30</sup>, R<sup>31</sup> or R<sup>32</sup> is present and is a therapeutic agent, are not obvious over the compounds of formula (I) because there is no teaching or suggestion in the claims of the '144 application of conjugation to a therapeutic agent. Moreover, claims 1-59 of the '144 application do not teach or suggest a compound within the scope of the presently claimed invention. The present claims are directed to compounds which are conjugated to a therapeutic agent whereas the claims of the '144 application recite compounds which are not conjugated to a therapeutic agent.

Thus, Applicants respectfully submit that claims 64-70 are patentably distinct from claims 1-59 of the '144 application.

For the above reasons, Applicants respectfully request withdrawal of the double patenting rejection.

#### CONCLUSION

Applicants respectfully request that the present remarks be made of record in the instant application. If any issues remain in connection herewith, the Examiner is respectfully invited to telephone the undersigned to discuss the same.

Respectfully submitted,

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